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| PRE-APPEAL BRIEF REQUEST FOR REVIEW  |  | Docket Number (Optional)<br>99-062   |                          |
| <p>I hereby certify that this correspondence is being sent by facsimile to fax number 571-273-8300; "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.1(a)]</p> <p>on <u>May 11, 2006</u></p> <p>Signature <u>Gregory Venuto</u></p> <p>Typed or printed name <u>Gregory Venuto</u></p>   |  | Application Number<br>09/253,653   | Filed<br>March 10, 2000  |
|  |  | First Named Inventor<br>Walker et al.  |                          |
|  |  | Art Unit<br>3624   | Examiner<br>Ella Colbert |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed in response to the Final Office Action mailed February 13, 2006.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s).</p> <p>Note: No more than five (5) pages may be provided.</p>  |  |  |                          |
| <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest.<br/>See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.<br/>(Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record.<br/>Registration number <u>203-461-7252</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34.<br/>Registration number if acting under 37 CFR 1.34 <u>May 11, 2006</u></p> |  | <p><u>Stephen J. Filipek</u><br/>Signature</p> <p>Stephen J. Filipek<br/>Typed or printed name</p> <p>203-461-7252<br/>Telephone number</p> <p>May 11, 2006<br/>Date</p> |                          |
| <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.<br/>Submit multiple forms if more than one signature is required, see below*.</p>  |  |  |                          |



\*Total of 1 forms are submitted.

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MAY 11 2006

CUSTOMER NO. 22927

Applicants: Walker et al.  
 Application No.: 09/523,653  
 Filed: March 10, 2000  
 Title: METHOD, SYSTEM AND COMPUTER PROGRAM PRODUCT  
       FOR FACILITATING AN AUCTION BEHAVIOR AND  
       AUTOMATIC BIDDING IN AN AUCTION  
 Attorney Docket No. 99-062  
 Group Art Unit: 3624  
 Examiner: COLBERT, Ella

Commission for Patents  
 P.O. Box 1450  
 Alexandria, VA 22323 1450

**REQUEST FOR PRE-APPEAL BRIEF CONFERENCE**  
**REMARKS AND ARGUMENTS**

**I. Introduction**

Applicants hereby request a pre-appeal brief conference for Application No. 09/523,653, to review the rejection of claims 1 – 24, 35 and 56. Claims 1 – 58 are currently pending, and claims 25—34, 36—55, 57 and 58 have been withdrawn from consideration.

Claims 1, 21, 35 and 56 stand rejected under 35 U.S.C. §112. All of the pending claims stand rejected under 35 U.S.C. §103(a) over U.S. Patent No. 6,012,045 to Barzilai et al. ("Barzilai" herein) in view of U.S. Patent No. 6,718,312 to McAfee et al. ("McAfee" herein). Applicants traverse these rejections for at least the following reasons:

- a *prima facie* case of indefiniteness has not been made because the Examiner has consistently misconstrued the term "auction behavior" (which is defined on page 9, lines 28-31 of the specification; we note that a clerical error was made when we first cited the page and line numbers for the definition, which we now correct below);
- the Examiner's interpretation of the pending claims is at odds with the definition of "auction behavior", and because this claim interpretation is apparently the basis for using the cited references, the Section 103 rejection is improper;
- the motivations the Examiner proposes for combining the two disparate references are legally insufficient, and thus the Section 103 rejections are improper; and
- various limitations recited by independent claims 1, 21, 22, 24, 35 and 56 are not found in the cited references.

**II. The 35 U.S.C. §112 Rejections**

We respectfully submit that the legal basis employed by the Examiner is unclear. In our previous response (November 23, 2005), we submitted that if an assertion is

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being made that an essential step is missing from the claims, then an essential elements rejection is a rejection for lack of enablement of the claimed invention, not indefiniteness. (See 1<sup>st</sup> paragraph of MPEP § 2172.01.) But the Examiner maintained the indefiniteness rejection and did not assert an enablement rejection (See the Final Office Action ("Final Action" herein), paragraph 4, page 2). Thus, we must assume that an enablement rejection was never intended, and that the Examiner is solely basing the rejection under 35 U.S.C. §112 on the Indefiniteness of the claims.

Claims are indefinite "if reasonable efforts at claim construction prove futile," that is, if a claim "is insolubly ambiguous, and no narrowing construction can properly be adopted." *Exxon Research & Engineering Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001). Even if it is a formidable task to understand a claim, and the result not unanimously accepted, as long as the boundaries of a claim may be understood it is "sufficiently clear to avoid invalidity [for] indefiniteness." *Id.* at 1375. See also *Invitrogen Corp. v. Biocrest Mfg., L.P.*, 424 F.3d 1374, 1383 (Fed. Cir. 2005).

#### A. Claim 1

On page 2 of the Final Action the Examiner contends: "It is unclear and vague in the claim language what Applicant's mean by "specified auction behavior" in claim 1... Is it automatically placing a bid for a bidder according to a rule?" In addition, on page 11 of the Final Action, the Examiner correctly notes that: "Page 8, lines 28-30 of the Specification... do not recite "An auction behavior is a manner in which bids in an auction are placed, for example, the times at which they are placed, the frequency with which they are placed, and the amount by which they exceed any previous bid."

In our November 23, 2005 response, we mistakenly directed the Examiner's attention to page 8, lines 28 - 30 of the specification. We apologize for our clerical error, and should have cited page 9, lines 28-31 of the specification, which clearly explains what is meant by auction behavior:

"An auction behavior is a manner in which bids in an auction are placed, for example, the times at which they are placed, the frequency with which they are placed, and the amount by which they exceed any previous bid."

We respectfully assert that the use of "specified" immediately before "auction behavior" clearly indicates that the second occurrence in claim 1 of the term "auction behavior" is the same as the first occurrence in claim 1. Accordingly, when read in light of the specification, there is no ambiguity to the language of claim 1. Thus, for all of the above reasons, there is no *prima facie* showing of indefiniteness of claim 1.

#### B. Claim 21

On page 2 of the Final Action the Examiner contends: "It is unclear and vague in the claim language what Applicants' mean by "identifying an auction behavior" and "the selected auction behavior" in claim 21...". Also, on page 11 of the Final Action: "The ... claim language does not particularly point out... how Applicants' "auction behavior is identified or what criteria is used for... "auction behavior"..."

From these statements, it is unclear exactly what portion(s) of claim 21 are deemed to render the claim indefinite. Specifically, the Examiner has not clarified whether (1) the broadest reasonable interpretation of claim 21 in light of the specification somehow alters the meaning of "identify" or of "selected" from their ordinary meaning, (2) the ordinary meaning of "identify" and "selected" is somehow antithetical to their

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usage in claim 21 regardless of any meaning that may be gleaned from the specification, (3) the ordinary meaning of "identify" and "selected" are somehow antithetical to their usage in claim 21 due to meanings that may be gleaned from the specification, or (4) some other reason or reasons.

As best understood, the rejection of claim 21 appears to be a request to indicate structure corresponding to the means-plus-function element of claim 21. The Examiner has not even alleged that any portion of the language of claim 21 is indefinite (i.e. insolubly ambiguous to one of ordinary skill in the art); the Examiner has merely requested an explanation of how the function is performed. In prior responses, we identified various structures in response to the rejection of claim 21. Accordingly, for all of these reasons, there is no *prima facie* showing of indefiniteness of claim 21.

#### C. *Claim 35*

On page 2 of the Final Action the Examiner contends: "It is unclear and vague in the claim language what Applicant means by ... a behavior selector in claim 35." Also, page 11 of the Final Action recites: "The ... claim language does not particularly point out... what criteria is used for... Applicants' "behavior selector".

From these statements, it is unclear exactly what portion(s) of claim 35 are deemed to render the claim indefinite. This appears to be a request to indicate the structure corresponding to the "behavior selector" of claim 35. The Examiner has not alleged that any portion of the language of claim 35 is indefinite (i.e. insolubly ambiguous to one of ordinary skill in the art); the Examiner has merely requested an explanation of what a particular component of the claim is. In our January 10, 2005 response, we identified various structures in reply to the rejection of claim 35 (for example, page 9, lines 20—26 of the specification describe one aspect of the auction behavior selector; and page 9, line 29 et seq. describe auction behavior selector 106). Accordingly, there is no *prima facie* showing of indefiniteness of claim 35.

#### D. *Claim 56*

Page 2 of the Final Action recites: "Claim 56 has a similar problem with "auction behavior". And on page 12 of the Final Action, the Examiner again remarks that there is no definition of "auction behavior" at page 8, lines 28-30. We again apologize for our clerical error, and reiterate that page 9, lines 28-31 clearly explains what is meant by "auction behavior" (see above).

Thus, the rejection of claim 56 appears to be a request to indicate what exactly the "behavior" will be as determined according to the method of claim 56. It is not clear if the Examiner has even alleged that any portion of the language of claim 56 is indefinite. We note that the behavior is determined in any of various manners described in the present application, and that the method of claim 56 is not limited to a specific behavior.

Accordingly, there is no *prima facie* showing of indefiniteness of claim 56.

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### III. The 35 U.S.C. §103(a) Rejections

Claims 1 - 24, 35 and 56 stand rejected as being unpatentable over a combination of Barzilai and McAfee. We traverse the Section 103(a) rejections as there has been no *prima facie* showing that the claims are obvious.

#### ***A. The Examiner's Claim Interpretation***

Under "Issue no. 4" on page 12 of the Final Action, the Examiner alleges that our previous submission, wherein we deduced that the Examiner interpreted the term "auction behavior" in the claims as reading on "[a]n auction behavior can be the electronic payment of funds from the bidder for each bid based upon the number of bids submitted by the bidder.", is moot because of our erroneous citation to the definition of "auction behavior" in the specification. We traverse the Examiner's assertion.

We again respectfully assert that the Examiner's interpretation is clearly at odds with the definition of "auction behavior" at page 9, line 28 of the application, which recites: "An auction behavior is a manner in which bids in an auction are placed, for example, the times at which they are placed, the frequency with which they are placed, and the amount by which they exceed any previous bid."

Since the Examiner's claim interpretation is legally unsupportable, and since this claim interpretation is apparently the basis for the usage of one or both references in the Section 103 rejection, the rejection is improper.

#### ***B. No Motivation to Combine***

Furthermore, the motivations the Examiner proposes for combining the two disparate references are all essentially statements that the proposed combination would "confer a benefit". This is clearly a legally insufficient basis for combining references, and so the rejection is improper. In particular, the insufficient motivations recited by the Examiner in the Final Action are as follows:

- Page 3, last paragraph: "because such a modification would allow Barzilai to have bid restrictions and additive activity rules to control the behavior of auction participants.;"
- Page 4, second full paragraph: "because such a modification would allow Barzilai to have a bidder's eligibility for current bidding dependent upon the past bidding activity according to activity rules.;"
- Page 7, second paragraph: "because such an incorporation would allow Barzilai to apply rules that make a bidder's eligibility for current bidding dependent upon the past bidding activity.;"
- Page 8, paragraph 3: "it would have been obvious to a skilled artisan for Barzilai to control when a bid may be placed automatically for a bidder in view of Barzilai's teachings of auction rules and bidding.;"
- Page 9, paragraph bridging pages 8 and 9: "...in view of Barzilai's teachings of rules, a password control and a rule display and because such a modification would allow Barzilai to permit a user to place a reasonable number of bids on a single product or service whereby the system accepts the highest bid submitted by all bidding customers".

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Attorney Docket No.: 99-062**C. Limitations of Independent Claims 1, 21, 22, 24, 35 and 56**

Despite the Examiner's assertion, neither reference discloses or suggests any *identifying an auction behavior*. For at least this reason, no *prima facie* case of obviousness of claim 1 or 21 has been shown.

Also, despite the Examiner's assertion on page 3, last paragraph of the Final Action, the cited portions of McAfee at Col. 1, lines 32-57 and Col. 4, lines 22-52 have nothing to do with "controlling when a bid may be placed automatically for a bidder". Rather, the first cited portion McAfee describes the differences between a silent auction and a "simultaneous ascending auction" (SAA), and the second cited portion explains decisions concerning how to structure lots in government-run auctions. Thus, we respectfully assert that these cited portions do not support the Examiner's statement.

Furthermore, contrary to the Examiner's assertion, no portion of Barzilai cited on page 8 of the Final Action has anything to do with a "selected auction behavior" or at least one rule that would "encourage the selected auction behavior". Space restrictions prevent us from reproducing the particular portions of Barzilai cited by the Examiner (i.e., Col. 10, lines 44-63, Col. 4, lines 7-10, Col. 5, lines 25-40, and Col. 10, lines 53-67), but we assert that these portions do not suggest or teach any such limitations. Thus, for at least this reason, no *prima facie* case of obviousness of claim 22 has been shown.

Claim 24 includes generally the same language described immediately above with respect to the rejection of claim 22. Thus, the rejection of claim 24 is flawed in at least the same manner, and therefore the Examiner's rejection of claim 24 does not demonstrate a *prima facie* case of obviousness.

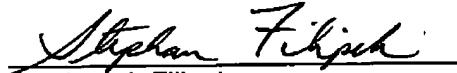
The rejection of claim 35 on page 10 of the Final Action is flawed in proposing that Barzilai discloses anything to do with *auction behavior*, much less the specific limitations the Examiner alleges. The first cited portion of Barzilai (col. 6, lines 27 - 37) only discloses that buyers may pay for bid charges with, e.g., a credit card account. The second cited portion of Barzilai (col. 6, lines 39 - 50) discloses that winning bids for a product generate a shipping order to a supplier. Accordingly, the rejection of claim 35 does not demonstrate a *prima facie* case of obviousness.

The rejection of claim 56 on page 10 of the Final Action is completely devoid of any detail, referring instead to the rejections of all other claims. Accordingly, no *prima facie* case of obviousness has been shown. Moreover, the rejection of claim 56 is further flawed in that no reference of record has anything to do with *determining a behavior of each of the concluded auctions from the bidding information*.

**IV. Conclusion**

In view of the above remarks, the Applicants respectfully request review and reversal of the rejection of claims 1-24, 35 and 56.

Respectfully submitted,

  
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May 11, 2006  
Date